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P. Walsh
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Koch, Frank J., et al.

Serial No: 09/542,640 (Reissue of Patent 5,930,744) Art Unit: 2857

Filing Date: April 3, 2000

Examiner: Unknown

For: COATING THICKNESS GAUGE

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.10

The undersigned hereby certifies that this document is being placed in the United States mail, Express Mail Post Office to Addressee, **Express Mail No. EL811608479US** addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the 6th day of August, 2001.

Maile Walsh

Assistant Commissioner for Patents
Washington, D.C. 20231

PROTEST UNDER 37 C.F.R. § 1.291(a)

Dear Sirs:

This is a Protest by Elcometer, Inc. and Elcometer Instruments Limited (hereinafter "Elcometer") against the above-referenced reissue application assigned to DeFelsko Corporation (hereinafter "DeFelsko").

Notice of the filing of the above-referenced Reissue Application was published in the Official Gazette on August 5, 2001. Elcometer respectfully requests that the Examiner having charge of the above-referenced reissue application enter the instant Protest in the application file and consider the merits of the enclosed documentation in support of the instant Protest. Protestor hereby states that the

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protest was served upon the Attorney of Record in the above-referenced reissue application in accordance with 37 C.F.R. §§1.291(a) and 1.248 on August 6, 2001.

Elcometer hereby submits the following in accordance with 37 C.F.R. § 1.291:

1. A list of each patent, publication, and other item of information relied upon is listed on the Form 1449 attached hereto as **Exhibit A**;
2. A concise explanation of the relevance of each item of information relied upon is attached hereto as **Exhibit B**;
3. A copy of each patent, publication, and other item of information relied upon is attached hereto as **Exhibits C1-C10**; and
4. A copy of the Certificate of Service is attached hereto as **Exhibit D**.

BACKGROUND

Elcometer and DeFelsko both manufacture coating thickness measurement instruments. In November of 1993, Elcometer discussed a new instrument, the 365 Elcometer, with customers in the United States. The Elcometer 365 instrument combined the data processing functions of an earlier model of Elcometer's, the Elcometer 500 instrument, along with the facilities to: 1) display a representation of the product from which coating measurements were to be taken; and 2) to guide the user by indicating on the representation where the measurement was to be taken. The measured values may be stored by the 365 instrument and associated with the position indicated on the representation where they were taken.

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In July of 1997, Elcometer became aware that DeFelsko had filed patent applications in both the U.S. and the U.K., each directed toward coating thickness measuring instruments having the same facilities as that of the Elcometer 365 instrument.

During prosecution of DeFelsko's U.K. Patent Application, Elcometer filed in the U.K. Patent Office: 1) Third Party Observations on the patentability of DeFelsko's patent application in the U.K. (hereinafter "the Third Party Observations," attached hereto as **Exhibit C1**); 2) an Affidavit executed on January 18, 1998 by Peter Baldwin (an employee of Elcometer) referring to various prior art documents attached thereto as Exhibits A-O, confirming the publication date of the prior art documents (hereinafter "the Affidavit," attached hereto as **Exhibit C2**); and 3) copies of the prior art documents referred to in the Affidavit and supporting the Third Party Observations (hereinafter "the First Batch," included with Exhibit C2.) The U.K. Patent Office raised objections to the U.K. patent application in response to Elcometer's submission of the foregoing. Copies of the Objections are attached hereto as **Exhibit C3**.

Copies of: 1) the Third Party Observations; 2) the Affidavit; and 3) the First Batch were forwarded to DeFelsko's U.K. agents for their U.K. application. The U.K. agent presumably sent these to DeFelsko's U.S. attorneys. In the meantime, a Notice of Allowance in connection with DeFelsko's U.S. case was mailed on May 22, 1997 indicating that the application would issue.

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On June 16, 1999, DeFelsko's attorneys filed in the U.S. Patent and Trademark Office: 1) a Petition to Withdraw the application from Issue; 2) a Continued Prosecution Application (CPA); and 3) an IDS listing selected items from the First Batch of prior art documents sent to DeFelsko's Attorney's. Thus, the IDS submitted by DeFelsko's attorneys on June 16, 1999 did not include the Third Party Observations, the Affidavit, or a complete list of prior art documents. The selected items submitted by DeFelsko were considered by the U.S. PTO during prosecution of the CPA on December 16, 1998 (as evidenced by the 1449 form initialed by the Examiner and attached hereto as **Exhibit C4**).

On May 14 and May 20, 1999, Elcometer's agents in the U.K. corresponded with DeFelsko's attorneys in the U.S. (copies of each letter are attached hereto as **Exhibits C5 and C6**). Elcometer provided additional prior art documents (hereinafter "the Second Batch," copies of which are included with **Exhibit C6**). On June 16, 1999, DeFelsko's attorneys filed in the U.S. Patent and Trademark Office an IDS listing each of the documents contained in the Second Batch.

The CPA issued as U.S. Patent No. 5,930,744 on July 27, 1999. The application issued as a patent: 1) without consideration of the "Second Batch" by the Patent Office (as evidenced by the 1449 form without the Examiner's initials and attached hereto as **Exhibit C7**); and 2) without any amendments in response to the First or Second Batches.

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DISCUSSION

The above-referenced reissue application was filed on April 3, 2000. In addition to the originally issued claims (1-30) submitted in unamended form, the reissue application contains new claims 31-45. It is Elcometer's position that the claims of Reissue Patent Application No. 5,930,744 are invalid because they are anticipated by or, in the alternative, obvious over the information relied upon by Elcometer, alone or in combination, for at least the following reasons.

1. Coating thickness measuring instruments that were capable of storing coated thickness measurements along with descriptive data were conventional and known at the time DeFelsko's original application was filed.
2. Interfacing computers with coating thickness measuring instruments was conventional and known at the time the original application was filed.
3. Computer software which enables a representation of a product to be displayed to guide a user was conventional and known at the time the original application was filed.
4. The Elcometer 365, which embodies all of the features of DeFelsko's instrument, was disclosed in a printed publication more than one year prior to the filing date of the original DeFelsko application.

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5. The Elcometer 365, which embodies all of the features of DeFelsko's instrument, was shown to potential customers in the U.S. more than one year prior to the filing date of the original DeFelsko application.

6. The Elcometer 365, which embodies all of the features of DeFelsko's instrument, was used in the U.S. more than one year prior to the filing date of the original DeFelsko application.

Elcometer's explanation of the information relied upon relative to the claims in the reissue application follows.

Original Independent Claim 1

Original independent claim 1 is directed to a method for measuring and recording coating thickness involving storing coating thickness data with associated descriptive data. Independent claim 1 recites:

"[a] method of recording coating thickness measurements,
comprising the steps of:

obtaining a plurality of coating thickness values with a probe
electrically connected to an electronic memory;

recording in the electronic memory the plurality of coating
thickness values; and

recording in the electronic memory a plurality of descriptive
data, each descriptive data is associated with a respective one of the
coating thickness values and provides information concerning the

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respective one coating thickness value."

It is conventional and logical when taking coating thickness measurements to write down the measurement along with a description or location of the measurement for later identification purposes. Claim 1 merely requires the use of a probe electronically connected to an electronic memory to implement this conventional method, which cannot be regarded as inventive.

The Elcometer 300, 355 and 365 coating thickness gauges each satisfy the requirements of claim 1. Each is equipped with a probe for obtaining coating thickness values and for storing these values in an electronic memory. In the case of the 300 and 355 gauges the descriptive data units may comprise the text Hi, Low Base Set or Calibrated. The 365 models enable descriptive data units relating to position to be stored. The EDCS system and the Dataputer systems when used in conjunction with an electronic coating thickness gauge also enable coating thickness values to be stored in conjunction with descriptive data units as well as enabling the data to be displayed graphically. The Fischer MMS system allows for the input of Alphanumeric Data in relation to individual coating thickness values.

Original Dependent Claims 2 through 9

Regarding claim 2 it is entirely logical, and hence obvious, to record coating thickness values and associated descriptive data alternately. This is the manner in which a human operator is most likely to work, not least to avoid forgetting the

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description of a value before recording that description. In any event it is difficult to see how there can be any inventive step in recording coating thickness values and descriptive data alternately rather than in any other way.

Claims 3 and 5 to 9 merely introduce further apparatus features and are obvious for at least the same reasons as claim 1.

Claim 4 requires that the descriptive data comprise text. Text is just one of a number of convenient forms of presenting data, if not the most convenient form for human operators. Thus, it would be obvious to those of ordinary skill in the art to consider the choice of text over any other data format.

Original Independent Claim 10

Original independent claim 10 is directed to an apparatus for measuring a coating thickness, including a PCMCIA card. Claim 10 recites:

"[a]n apparatus for measuring a coating thickness, comprising:
a probe which generates a first signal representative of a measured coating thickness; and
a PCMCIA card connected to the probe and which receives the first signal from the probe, the PCMCIA card including means for converting the first signal into a second signal which is compatible with a standard PCMCIA output format."

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It was known at the time the original application was filed to interface coating thickness measurement instruments/probes with standard computers. Interfacing equipment with conventional computers using PCMCIA cards was known at the time the application was filed. It would therefore have been obvious for those skilled in the art at the time the application was filed to use a PCMCIA card to interface a coating thickness measurement probe with a conventional computer. Claim 10 is therefore obvious over the Elcometer EDCS and/or SPC FocusPLUS in combination with the fact that the use of PCMCIA cards was a known way of interfacing equipment with conventional computers.

Original Dependent Claims 11-15

The features recited in dependent claims 11 to 15 were all known at the time the application was filed in relation to coating thickness measurement gauges, as shown in the file history of the original patent. It would have been obvious to those of skill in the art at the time the invention was made to include any of the features recited in dependent claims 11 to 15 in a coating thickness measuring apparatus.

Original Dependent Claim 17

Dependent claim 17 merely combines the requirement of a means for storing descriptive data with that of a PCMCIA card and is obvious for at least the same reasons discussed above.

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Original Dependent Claims 18 and 19

Dependent claims 18 and 19 recite features which are found in the Apple Newton computer referred to in the original patent and which is prior art in relation to the patent. It was known to connect coating thickness measurement instruments/probes to computers. The Apple Newton is merely one of a number of computers from which those of skill in the art would have chosen at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an Apple Newton to provide the features of claims 18 and 19.

Original Dependent claim 20

Dependent claim 20 is anticipated by and/or obvious over the Elcometer 365, the Elcometer 300, or the Elcometer 500, and the Fischerscope MMS in combination with SPC FocusPLUS and/or the "Introducing the 365" leaflet 9.

Original Independent Claim 21

Original independent claim 21 is directed to an apparatus for measuring and recording coating thickness involving storing coating thickness data with associated descriptive data. Claim 21 recites:

"[a]n apparatus for measuring and recording coating thickness measurements, comprising:
an electronic memory;
means for obtaining a plurality of coating thickness values

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with a probe electrically connected to the electronic memory;
means for recording in the electronic memory the plurality of
coating thickness values; and
means for recording in the electronic memory a plurality of
descriptive data so that each descriptive data is associated with a
respective one of the coating thickness values and provides
information concerning the respective one coating thickness value."

Original independent claim 21 is anticipated by or obvious over the Elcometer 300, the Elcometer 365, the Elcometer 500, and the Fischerscope MMS, each of which includes "means for recording in the electronic memory a plurality of descriptive data so that each descriptive data is associated with a respective one of the coating thickness values and provides information concerning the respective one coating thickness value." Instruments capable of storing descriptive data were clearly known at the time the original application was filed, and the remaining claim limitations are elements that were well known by those of skill in the art at the time the original application was filed.

As described above, the Elcometer 300, 355 and 365 coating thickness gauges all satisfy the requirements of claim 21. Each is equipped with a probe for obtaining coating thickness values and for storing these values in an electronic memory. In the case of the 300 and 355 gauges the descriptive data units may comprise the text Hi, Low Base Set or Calibrated. The 365 models enable descriptive data units relating

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to position to be stored. The EDCS system and the Dataputer systems when used in conjunction with an electronic coating thickness gauge also enable coating thickness values to be stored in conjunction with descriptive data units as well as enabling the data to be displayed graphically. The Fischer MMS system allows for the input of Alphanumeric Data in relation to individual coating thickness values.

Original dependent claim 22

Dependent claim 22 is obvious over the Elcometer EDCS and/or the SPC FocusPLUS in combination with the fact that the use of PCMCIA cards were a known way of interfacing equipment with conventional computers. It was known to those of ordinary skill in the art at the time the invention was made to interface coating thickness measurement instruments/probes with standard computers. It would therefore have been obvious to those of skill in the art at the time the invention was made to use a PCMCIA card to interface a coating thickness measurement probe with a conventional computer.

Claims 23 to 25

Claim 23 requires that the descriptive data comprise text. As stated above, text is just one of a number of convenient forms of presenting data, if not the most convenient form for human operators. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose text over any other data format. Claim 23 fails to add anything to claim 21 and is not patentable for at least the same reasons set forth above with respect to claim 21. Claim 25 is

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anticipated by an arrangement involving a pictorial representation of a coated article where coating thickness measurements are stored in relation to positions on the article.

Claim 29

Because claim 21 is known and/or obvious then an apparatus including a known input device, such as the alphanumeric key pad of the Fischerscope MMS system, should also be regarded as known and/or obvious as it only represents a logical use of such apparatus.

Original dependent claims 21, 26, 28, and 30

Dependent claims 21, 26, 28, 30 are anticipated by or obvious over the Elcometer 300, 365 and 500 and Fischerscope MMS. Instruments capable of storing descriptive data were clearly known. It is noted that claims 26, 28 and 30 concern features which are customary.

New claims 39-41

New claims 39-41 are directed to an apparatus that includes a commercially available computing device. New independent claim 39 recites:

"[a]n apparatus for taking a coating thickness measurement,
comprising:

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a probe which generates a signal representative of a measured coating thickness; and

a connector connected to the probe for connecting the probe to any one of a number of different commercially available types of nondedicated, palm-size, personal computing devices, the connector including a standard interface usable with any one of the personal computing devices."

New independent claim 39

New independent claim 39 is anticipated by or obvious over the Elcometer EDCS and/or the SPC FocusPLUS. It was known to those of ordinary skill in the art at the time the invention was made to connect coating thickness measuring probes to a conventional computer. Selecting a palm sized computer over any other conventional computer cannot be regarded as inventive. Moreover, the language of the claim is unclear and the scope of the claim would be difficult, if impossible, to accurately determine. Further, as discussed above, the use of a standard interface must be regarded as obvious.

New dependent claim 40

New dependent claim 40 is likewise unclear and the addition of a PDA does not add any inventive merit over claim 39.

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New dependent claim 41

New dependent claim 41 recites a computer screen, which is generally included in computers of all types. The Apple Newton includes a touch sensitive screen. As discussed above it is believed obvious to use an Apple Newton.

New claims 42-45

New claims 42-45 are directed to an apparatus for taking coating thickness measurements. New independent claim 42 recites:

"[a]n apparatus for taking a coating thickness measurement,
comprising:

 a probe which generates a signal representative of a measured
 coating thickness;

 a signal convertor that receives the signal generated by the
 probe; and

 a connector connected to the signal convertor for connecting
 the apparatus to any one of a number of different commercially
 available types of nondedicated, palm-size, personal computing
 devices, the connector including a standard interface usable with any
 one of the personal computing devices.

New independent claim 42

New independent claim 42 is anticipated by or obvious over the Elcometer EDCS and/or the SPC FocusPLUS. Instruments including a probe, a signal

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convertor, and a connector were certainly known to those of ordinary skill in the art at the time the invention was made. Further, as discussed above, the use of a standard interface must be regarded as obvious.

New dependent claims 42 and 43

New dependent claim 43 is unclear, and the addition of a PDA does not add any inventive merit over claim 42.

New dependent claim 44

New dependent claim 45 is unclear and the addition of the limitation of "a screen display interface" does not add any inventive merit over claim 41, as such screens are generally included in computers of all types.

CONCLUSION

Elcometer recognizes that the Patent Office is not required to comment on the prior art references but would appreciate any efforts by the Patent Office in this regard.

A self-addressed stamped envelope is enclosed for acknowledgment of receipt of the instant Protest by the USPTO.

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The U.S. Patent and Trademark Office is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our deposit account #19-0120.

Respectfully submitted,
Elcometer Instruments Limited and
Elcometer Inc., PROTESTORS

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